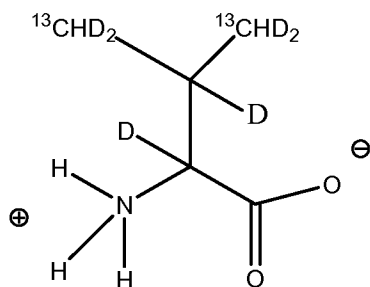


Art Unit: 1654

Pursuant to preliminary amendment (filed 1/14/08), claims 1-11 have been cancelled, and claims 12-17 added. Claims 12-17 are now pending.

The claims are now drawn to a protein, and, according to applicants, a protein can consist of one single amino acid. Whatever the merits of such a proposition, applicants have elected the following amino acid (which is a “protein” in applicants’ lexicon):



In this compound, the isotope of nitrogen is ^{14}N .

Applicants have argued that claims 16 and 17 encompass the elected amino acid. However, this is not possible, since the elected amino acid does not contain ^{15}N , whereas claims 16 and 17 mandate the presence of ^{15}N .

In the discussion (filed 1/14/08), applicants have explained that the quality or state of being “active” or “inactive” is not an inherent one, but rather is dependent on the conditions of observance of the compound in question. As such, the exact conditions of observance become an issue. Applicants have not explicitly stated what the elected conditions might be under which the elected

Art Unit: 1654

amino acid is to be observed, but have nevertheless pointed out that under the conditions of example 3, deuterium atoms are NMR inactive, and further, that under these conditions, ^{13}C is not “picked up” by NMR. This statement that ^{13}C is not “picked up” by NMR is taken to mean that the ^{13}C is inactive. If it is true that ^{13}C is inactive, it then follows that the elected compound does not fall within the scope of any of the claims. If it is true that the elected compound does not fall within the scope of any of the claims, then it follows that applicants are “non responsive” to the election of species requirement. On the other hand, it may be the case that, in applicants’ lexicon, when a nucleus is “not picked up”, that really means that it is “active”.

In response to this Office action, applicants should either reaffirm the elected compound, or elect another.

In addition, an election of each of the following is required (under 35 U.S.C. §121):

- a) the NMR “conditions” under which the elected compound is to be observed;
- b) one of the following: (i) under the elected conditions, ^{13}C is NMR active, or (ii) ^{13}C is NMR inactive;
- c) one of the following: (i) under the elected conditions, deuterium is NMR active, or (ii) deuterium is NMR inactive;
- d) one of the following: (i) under the elected conditions, ^1H is NMR active, or (ii) ^1H is NMR inactive;
- e) one of the following: (i) under the elected conditions, ^{12}C is NMR active, or (ii) ^{12}C is NMR inactive;

Art Unit: 1654

f) one of the following: (i) under the elected conditions, ^{14}N is NMR active, or (ii) ^{14}N is NMR inactive.

(The foregoing elections are necessary in view of applicants' "creative" semantic system).

Applicant is advised that a response to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a generic claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

Upon allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP 809.02(a).

Should applicant traverse on the ground that the species are not patentable distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. , 103 of the other invention.

△

Art Unit: 1654

Any inquiry concerning this communication or earlier communications from the examiner should be directed to David Lukton whose telephone number is 571-272-0952. The examiner can normally be reached Monday-Friday from 9:30 to 6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Cecilia Tsang, can be reached at (571)272-0562. The fax number for the organization where this application or proceeding is assigned is 571-273-8300.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 571-272-1600.

/David Lukton/

Primary Examiner, Art Unit 1654